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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,097	08/22/2003	Hugh M. Herr	OSSUR.010C1	8407
20995	7590	12/14/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				BLANCO, JAVIER G
ART UNIT		PAPER NUMBER		
3738				

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TAK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/646,097	HERR ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Javier G. Blanco	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 1-58 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 59-70 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/24/2005</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendment of claim 59 in the reply filed on August 24, 2005 is acknowledged.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 65-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 14, 18, 19, 20, and 27 of U.S. Patent No. 6,610,101 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 65-69 of the application and claims 13, 14, 18, 19, 20, and 27 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 13, 14, 18, 19, 20, and 27 is in effect a "species" of the "generic" invention of claims 65-69. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed.

Cir. 1993). Since claims 65-69 are anticipated by claims 13, 14, 18, 19, 20, and 27 of the patent, it is not patentably distinct from claims 13, 14, 18, 19, 20, and 27.

This rejection was previously addressed in the Office Action of April 21, 2005.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 59-70 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Biedermann (US 6,423,098, B1; cited in Applicants' IDS).

Referring to Figure 1, Biedermann discloses a prosthetic knee system, and the method of controlling it (see column 2, lines 43-65), comprising a rotary magneto-rheological damper/brake operating in shear mode (see column 1, line 67 to column 2, line 14; column 3, lines 1-7), a knee angle sensor (see column 2, lines 15-17), a load sensor (see column 2, lines 24-32; strain gauges are well-known load sensors), and a control unit 10 comprising a CPU and a data memory (see column 2, lines 33-42). At least one knee movement characteristic is measured, identified as a “control state”, which “control state” is used to calculate a damping value, which damping value is used to control the resistance of the rotary magneto-rheological damper/brake operating in shear mode (see entire document).

***Response to Arguments***

6. With regards to the 102(e) rejection based on Biedermann (US 6,423,098, B1; cited in Applicants' IDS), Applicants' arguments filed August 24, 2005 have been fully considered but they are not persuasive.

a. Applicants argue that Biedermann '098 does not disclose/suggest that the liquid is "sheared in any form or manner". The Examiner respectfully disagrees. The broad claim language of independent claim 59 and independent claim 65 claims the "magnetorheological damper operating in shear mode". Several online dictionaries (e.g., Merriam-Webster, Dictionary.com, Encarta, etc.) define the term "shear" or "sheared" (in the physics context) as: "*To become deformed by forces tending to produce a shearing strain*"; "*To subject to a shear force*"; "*To cause to move along the plane of contact*". It should be noted that Biedermann optionally disclose a rotary piston "provided with vanes having a defined resistance within the cylinder dependent on the viscosity of the magneto-rheological liquid" (see column 3, lines 1-7), which rotary piston provided with vanes will subject the magneto-rheological liquid to shearing strain/stress.

7. Claims 59-70 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Deffenbaugh et al. (US 6,764,520 B2).

Referring to Figures 1-51, Deffenbaugh et al. disclose a prosthetic knee system, and the method of controlling it, comprising the claimed structural and functional limitations as set forth in claims 59-70 (see entire document).

8. With regards to the 102(e) rejection based on Deffenbaugh et al. (US 6,764,520 B2), Applicants' arguments filed August 24, 2005 have been fully considered but they are not persuasive.

a. Applicants argue that Deffenbaugh et al. '520 does not disclose/suggest the subject matter of claims 59-70. The Examiner respectfully disagrees. The entire context of US 6,764,520 B2 is based on using sensors/detectors to measure a characteristic of knee movement/motion (e.g., angle, strain, etc.), and using those measurements to identify (using a control system, software, or CPU) a state/phase (i.e., stance/flexion, stance/extension, etc.) to send a signal and control the resistance of a rotary magneto-rheological damper/brake operating in shear mode (see, for example, column 22, lines 20-37; column 25, line 64 to column 26, line 9; column 27, lines 5-17; and Figures 1-51).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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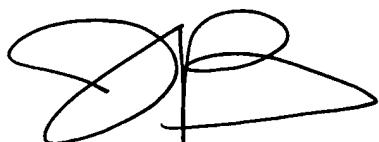
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. This application contains claims 1-58 drawn to an invention nonelected without traverse in the Paper filed on January 31, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-6:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



December 8, 2005



David H. Willse  
Primary Examiner